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EXAMINER

SNAPP, SANDRA S

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/722,607

Applicant(s)

WHITE ET AL.

Examiner

Sandra Snapp

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M4

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1- 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 13 are indefinite because in lines 8 (claim 1) and 9 (claim 13), respectively, the phrase “a bid” in the step of receiving is confusing. It is unclear whether the bid is a new, different bid, or the same bid as previously recited in lines 2 (claim 1) and 3 (claim 13). If it is the same bid, it should be preceded by “the” or “said.” If it is a different bid, it should be distinguished so there is no confusion with the previously recited bid. Also, in both claims 1 and 13, there is a “weighing” and a “weighted value” which are confusing to the Examiner. Isn’t the “weighing” a value also? If both are values, then the way they are currently claimed is confusing and should be clarified.

Claims 12 and 24 are indefinite because in the phrases “a weighted value” and “a score” in lines 4 & 6 (claim 12) and lines 3 & 5 (claim 13) are confusing. It is unclear whether the weighted value and the score are new, different values and scores, or the same values and scores as previously recited in claims 1 and 13. If they are the same, they should be preceded by “the”

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or “said.” If they are different, they should be distinguished so there is no confusion with the previously recited value and score.

Claims 25-28 are indefinite because it is unclear what is meant by the term “window.” By using the term “window” is the Applicant referring to the display on a computer, the software associated with the display, or even the hardware required to create the display? Clarification is required.

Claim 27 is indefinite because the phrase “a score” in line 3 is confusing with the composite score, since the composite score is also calculated according to values entered. Clarification is required.

Claims 1-12 and 14-23 are indefinite because they depend from rejected base claims 1 and 13.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**With regard to claims 1-12**, the claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-12 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of

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Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001)(Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

**With regard to claims 13-24**, the claims are rejected under 35 U.S.C. 101 because they are merely functional descriptive material. Functionally descriptive material per se is not statutory. *In re Warmerdam*, 33 F.3d 1360, 31 USPQ2d 1759. Claims 13-24 claim computer readable medium, however there is no express computer executable code or computer executable instructions, such are merely implied. Without the executable code or instructions, there is no nexus between the computer readable medium, and the steps it is charged with performing, and thus the claims fail to meet the statutory requirements under 35 U.S.C. 101. To successfully overcome this rejection, the Examiner suggests reciting that the computer readable medium has computer executable code or computer executable instructions for carrying out the various steps as recited in the body of the claim. See M.P.E.P. 2106.

**With regard to claims 25-28**, the claims are rejected under 35 U.S.C. 101 because they are merely non-functional descriptive material. Non-functionally descriptive material per se is not statutory. *In re Warmerdam*, 33 F.3d 1360, 31 USPQ2d 1759. Claims 25-28 merely claims windows, which fails to meet the statutory requirements under 35 U.S.C. 101, because it is not embodied or interrelated with some form of structure or technology. Such windows could be

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merely icons, screens or displays on a computer, which are not patentable per se. See M.P.E.P. 2106.

Claims 25-28 are also rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 25-28 lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001)(Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

Claims 25-28 are also rejected under 35 U.S.C. 101 as failing to produce a useful, concrete, tangible result. Specifically, the claims are nothing more than a manipulation of an abstract idea which is nonstatutory under 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by the Odom et al. patent (US 6,058,379).

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The Odom patent discloses a method, and associated computer system, for conducting an auction for a sponsor, comprising:

Receiving information for setting a composite score for a bid submitted to the auction (col. 5, lines 25-45), the information for setting the composite score comprising:

a selection of at least one of a plurality of categories as evaluation criteria for the bid (col. 5, lines 25-45), setting of parameters for each of the selected categories (col. 5, lines 25-45), a weighting specified for each of the selected categories (col. 5, lines 25-45),

receiving a bid from one or more participants (col. 6, lines 27-55), calculating a weighted value for each one of the selected categories based on the parameters and weighting for each of the selected categories and the information in the bid (col. 6, lines 27-55), determining a score for each received bid based on the weighted values for each of the selected categories (col. 6, lines 45-55), and identifying the bid having the highest score (col. 6, lines 45-55) (claims 1 and 14);

Receiving a designation of the participants who may submit bids to the auction (col. 6, lines 15-20 and 45-58) (claims 2 and 14);

Sending a notification to each of the participants based on the received designation (col. 6, lines 56-58) (claims 3 and 15);

At least one of the selected categories is set to a value provided by the sponsor (col. 5, lines 25-45) (claims 4 and 16);

At least one of the selected categories set to a value provided by the sponsor relates to an evaluation of the participant by the sponsor (col. 6, lines 35-58) (claims 5 and 17);

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The plurality of categories include a price, a distance, a quality, a volume and a lead time (col. 5, lines 25-45) (claims 6 and 18);

Notifying the participant having the bid identified as having the highest score (col. 6, lines 56-58) (claims 7 and 19);

The information for setting the composite score further comprises a selection of at least three of the plurality of categories as evaluation criteria for the bid (col. 5, lines 25-45) (claims 8 and 20);

The information in the bid includes values corresponding to the selected categories (col. 6, lines 20-45) (claims 9 and 21);

The calculating of a weighted value for each one of the selected categories comprises: scaling the values included in the information in the bid with the parameters set for each of the selected categories (col. 6, lines 26-44), and adjusting the scaled values with the weighting specified for each of the selected categories (col. 5, lines 25-45) (claims 10 and 22);

Determining of the score further includes the adjusted values (col. 6, lines 45-55) (claims 11 and 23); and

Receiving values corresponding to the selected categories before the bid is submitted (col. 6, lines 1-4), calculating a weighted value for each one of the selected categories based on the parameters weighting for each of the selected categories and the received values (col. 6, lines 27-55), determining a score based on the weighted values for each of the selected categories (col. 6, lines 45-55), and displaying the score to the participant from which the values were received (col. 6, lines 45-55) (claims 12 and 24).



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The Odom patent also discloses a window in a graphical user interface for an auction, comprising:

An auction window operable to display information describing the content of the auction as provided by the sponsor (col. 3, lines 24-27), a composite score window operable to display at least two of a plurality of categories selected as evaluation criteria for a bid (col. 5, lines 46-48), a value entered for each of the selected categories (col. 6, lines 27-44), and a composite score calculated according to the values entered for each of the selected categories (col. 6, lines 45-55), parameters set for each of the selected categories (col. 6, lines 27-55), and a weighting specified for each of the selected categories (col. 5, lines 25-45) (claim 25);

The composite score window is further operable to display an indication of the weighting specified for each of the selected categories (col. 6, lines 27-55) (claim 26);

The composite score window is further operable to display a score corresponding to the highest calculated composite score and a score corresponding to values most recently submitted by a participant of the auction (col. 6, lines 27-55) (claim 27); and

The composite score is displayed before the values are submitted to the auction (col. 6, lines 27-55) (claim 28).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Mori et al., Rickard et al., Fraser et al., Silverman et al., Hawkins et al., Harris et al., Herrington et al., Fraser et al., Nymeyer, Ausubel, Tuck et al., Hoffer, Hunt et al., Brett et al.,

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Shepard and Jong patents and applications all disclose various types of auctions, trading systems or exchanges.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

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